

REMARKS

Claims 1, 2, 5, and 7 are currently pending, wherein claim 9 has been canceled. Favorable reconsideration is respectfully requested in view of the remarks presented herein below.

At the outset, Applicants note that they have not received an Examiner initialed copy of the SB08 form included with the Information Disclosure Statement filed on August 2, 2007 indicating that the Examiner has considered the references listed thereon. Accordingly, Applicants are submitting herewith a copy of the SB08 original filed on August 2, 2007. Consideration of the references and an initialized copy of the of the SB08 is respectfully requested.

On page 3 of the final Office action ("Action"), the Examiner rejects claim 1 under 35 U.S.C. § 103(a) as being unpatentable over Gogerty in view of U.S. Patent No. 5,697,844 to Von Kohorn ("Von Kohorn"). Applicants respectfully traverse this rejection.

In order to support a rejection under 35 U.S.C. § 103, the Examiner must establish a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness three criteria must be met. First, there must be some motivation to combine the cited references. Second, there must be a reasonable expectation of success. Finally, the combination must teach each and every claimed element. In the present case, claim 1 is patentable over the combination of Gogerty and Von Kohorn for at least the reason that the combination fails to disclose or suggest a *winning probability decider* for deciding a winning probability of a drawing of lots *applied* to a *user of the second mobile terminal* according to the send information stored in the storage as claimed.

In response to Applicants previous arguments, the Examiner asserts the Von Kohorn reference teaches "the winning probability is weighted based on a superior score, which is analogous to weighting a winning probability decider based on the highest number of e-mails received or the largest volume of received e-mails in the instant application." The Examiner further asserts that "[t]he fact that [the] Van Kohorn reference does not use received e-mails as a criterion is not necessary, because that feature is already taught in the primary Gogerty reference, Von Kohorn reference was included only to show weighting of a winning probability criterion,

which it adequately does.” (See page 17 of the Action). Finally, the Examiner concludes that it would have been obvious to one skilled in the art to include “a winning probability decider for deciding a winning probability of a drawing of lots applied to a user of the second mobile terminal according to the sent information stored in the storage, as taught by Von Kohorn, in the claimed server of Gogerty, so that the customer with superior scores (parameters that contribute more to the service provider’s revenue, such as higher number of received e-mails or larger volume of e-mail content of the instant application) have a better chance of winning the lottery, and therefore be tempted to further enhance the revenue generation prospectus of the service provider.” Applicants respectfully disagree.

The Examiner appears to assert that the superior scores of Von Kohorn are parameters that contribute to the service provider’s revenue (see page 6, lines 9-11 of the Action) and that the genus of the “parameters contributing to the service provider’s revenue” includes the number of received e-mails and the volume of e-mail content of this application. Accordingly, the Examiner derives, from the disclosure of Von Kohorn (superior scores), a genus that “parameters contributing to service provider’s revenue.” However, Von Kohorn does not disclose that the species “superior scores” belongs to the genus “parameters contributing to service provider’s revenue”, neither explicitly nor implicitly. Also, the Examiner does not provide any explanation as to what part of the cited references supports that the genus (“parameters contributing to service provider’s revenue”) can be derived from the species (“superior scores”). The Examiner newly creates that genus (“parameters contributing to service provider’s revenue”), which is not supported by cited references.

Furthermore, even if *arguendo*, one skilled in the art had some rationale to combine the superior scores of Von Kohorn into the server of Gogerty, the combination would still fail to disclose a winning probability decider for deciding a winning probability of a drawing of lots applied to a user of the second mobile terminal according to the send information stored in the storage as claimed because the combination fails to disclose deciding a winning probability of a drawing of lots applied to the *second mobile terminal*. To the contrary, both Gogerty and Von Kohorn only disclose awarding prizes to the *sender* of emails/messages not the receiver as claimed. See Fig. 4 of Gogerty which clearly teaches determining if the *sender* is a winner.

Since Gogerty and Von Kohorn both fails to disclose or suggest a winning probability decider for deciding a winning probability of a drawing of lots *applied* to a *user of the second mobile terminal* according to the send information stored in the storage as claimed, the combination of these two references cannot possibly disclose or suggest said element. Therefore, even if one skilled in the art had some rationale to combine Gogerty and Von Kohorn (which Applicants do not concede), the combination would still fail to render claim 1 unpatentable because the combination fails to disclose each and every claimed element. Reconsideration and withdrawal of the rejection of claim 1 under 35 U.S.C. § 103 is respectfully requested.

On page 6 of the Action, the Examiner rejects claim 2 under 35 U.S.C. § 103(a) as being unpatentable over Gogerty in view of Von Kohorn, further in view of U.S. Patent Application Publication No. 2001/0051896 A1 to Noh et al. (“Noh”). Applicants respectfully traverse this rejection.

Claim 2 depends from independent claim 1. Therefore, claim 2 is patentable over the combination of Gogerty and Von Kohorn for at least those reasons presented above with respect to claim 1. Noh discloses a system for electronic mail enclosing a gift coupon. However, Noh fails to overcome the deficiencies of Gogerty and Von Kohorn.

Since Gogerty, Von Kohorn, and Noh each fail to disclose or suggest a winning probability decider for deciding a winning probability of a drawing of lots applied to a user of the second mobile terminal according to the send information stored in the storage as claimed, the combination of these three references cannot possibly disclose or suggest said element. Therefore, even if one skilled in the art had some rationale to combine Gogerty, Von Kohorn, and Noh (which Applicants do not concede), the combination would still fail to render claim 2 unpatentable because the combination fails to disclose each and every claimed element. Reconsideration and withdrawal of the rejection of claim 2 under 35 U.S.C. § 103 is respectfully requested.

On page 8 of the Action, the Examiner rejects claim 5 under 35 U.S.C. § 103(a) as being unpatentable over Gogerty in view of Von Kohorn, further in view of U.S. Patent Application

Publication No. 2002/0061778 A1 to Acres ("Acres"). Applicants respectfully traverse this rejection.

Claim 4 depends from independent claim 1. Therefore, claim 4 is patentable over the combination of Gogerty and Von Kohorn for at least those reasons presented above with respect to claim 1. Acres discloses a method and system for playing computer games sent via electronic mail. However, Acres fails to overcome the deficiencies of Gogerty and Von Kohorn.

Since Gogerty, Von Kohorn, and Acres each fail to disclose or suggest a winning probability decider for deciding a winning probability of a drawing of lots applied to a user of the second mobile terminal according to the send information stored in the storage as claimed, the combination of these three references cannot possibly disclose or suggest said element. Therefore, even if one skilled in the art had some rationale to combine Gogerty, Von Kohorn, and Acres (which Applicants do not concede), the combination would still fail to render claim 4 unpatentable because the combination fails to disclose each and every claimed element. Reconsideration and withdrawal of the rejection of claim 4 under 35 U.S.C. §103 is respectfully requested.

On page 10 of the Action, the Examiner rejects claim 7 under 35 U.S.C. § 103(a) as being unpatentable over Gogerty in view of Von Kohorn, further in view of Acres, and still further in view of U.S. Patent Application Publication No. 2003/0191816 A1 to Landress et al. ("Landress"). Applicants respectfully traverse this rejection.

Claim 7 depends from independent claim 1. Therefore, claim 7 is patentable over the combination of Gogerty and Von Kohorn for at least those reasons presented above with respect to claim 1. Landress discloses a system and method for creating and delivering customized multimedia communications. However, Landress fails to overcome the deficiencies of Gogerty and Von Kohorn.

Since Gogerty, Von Kohorn, and Landress each fail to disclose or suggest a winning probability decider for deciding a winning probability of a drawing of lots applied to a user of the second mobile terminal according to the send information stored in the storage as claimed, the combination of these three references cannot possibly disclose or suggest said element. Therefore, even if one skilled in the art has some rationale to combine Gogerty, Von Kohorn,

and Landress (which Applicants do not concede), the combination would still fail to render claim 7 unpatentable because the combination fails to disclose each and every claimed element. Reconsideration and withdrawal of the rejection of claim 7 under 35 U.S.C. §103 is respectfully requested.

On page 13 of the Action, the Examiner rejects claim 9 under 35 U.S.C. § 103(a) as being unpatentable over Gogerty in view of U.S. Patent No. 6,016,338 to Bansal et al. ("Bansal"). Claim 9 has been canceled, rendering this rejection moot.

The application is in condition for allowance. Notice of same is earnestly solicited. Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Penny Caudle Reg. No. 46,607 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Dated: November 3, 2009

Respectfully submitted,

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